

REMARKS/ARGUMENTS

Applicants would like to thank the Examiner for the careful consideration given the present application. Claims 1-58 were pending, with claims 1-5, 10, 15-19, 22-25, 29, 31, 32, 40-43, 45, 52, 53, and 55-58 remaining under examination. Applicant has amended claims 1, 15, 23, 53, and 55, and has added new claims 59-64. Accordingly, the claims now under examination are claims 1-5, 10, 15-19, 22-25, 29, 31, 32, 40-43, 45, 52, 53, and 55-64. Reconsideration of the application is requested in view of the amendments and comments provided herein.

Applicants appreciate the Examiner's indication that claims 53 and 55 would be allowable if rewritten in independent form. Applicants have amended claim 53 to include the limitations of the base claim, claim 1. New claims 59-63 are similar to previous dependent claims 2-5, 10 and 52 except for their new dependency on claim 53. Because claim 55 depended on claim 2, it has been amended to depend on new claim 59, which is a reflection of former claim 2. Applicants therefore believe that claims 53, 55, and 59-63 are now allowable.

Claims 1-5, and 52 were rejected under 35 U.S.C. §103(a) as being unpatentable over Chow (U.S. Patent No. D413,152). Applicants respectfully traverse the rejection. However, in the interest of furthering prosecution, Applicants have further amended claim 1 to recite an image secured to the first mounting plate that is substantially flat. Applicants respectfully submit that the amendment does not introduce new matter, in view of the 48 figures which illustrate substantially flat images, and in view of the discussion of images in the specification.

In order to demonstrate the *prima facie* obviousness of an invention, the Examiner is required to carry out a *Graham*-type analysis in which all claim limitations are considered. However, the football player shown in Chow is clearly a statue-like three dimensional figure (i.e., a novelty figurine), as indicated by the side views of Figures 3 and 4, and thus Chow

does not teach or suggest that a substantially flat image be secured to a mounting plate, as required by the claims as amended.

Furthermore, use of a substantially flat image provides a number of advantages over the novelty figurine taught by Chow. Chow provides a figurine which appears to have the capability to wobble when placed upright on a surface. However, it is unlikely that this figurine would provide wobble when the device was laid horizontally on a surface (i.e., perpendicular to the force of gravity), because the relatively bulky three dimensional figurine would weigh too much and thus would not wobble but would rather just hang. The figurine can wobble when directly supported by the spring (i.e., when it is upright), because the spring serves to resist the force of gravity. The present invention, on the other hand, is completely capable of providing wobble regardless of orientation due to the relatively lower mass of a substantially flat image. In fact, the numerous illustrations provided all indicate a device capable of providing wobble when the spring is positioned perpendicular to the force of gravity.

For at least the reasons discussed above, Chow does not render obvious claims 1-5 and 52, as amended. Withdrawal of this rejection is respectfully requested.

The Examiner further rejected claim 10 under 35 U.S.C. §103(a) as being unpatentable over Chow in view of Micco (U.S. Patent No. 5,280,905), which describes a football tackle dummy that includes an electronic sound device. However, Micco does not overcome any of the deficiencies noted above with regard to Chow et al., and thus does not render claim 10 obvious over Chow in view of Micco. Accordingly, Applicants also respectfully request the withdrawal of this rejection.

Claims 15, 18, 19, and 56 were rejected under 35 U.S.C. §102(b) as being anticipated by Del Mas (U.S. Patent No. 2,760,303). Applicants respectfully traverse the rejection. However, in the interest of furthering prosecution, Applicants have further amended claim 15 to recite an image coupled to the body that is substantially flat.

In order for a reference to anticipate a claim under 35 U.S.C. §102(b), it must teach each and every limitation of the claims. However, the articulated toy figure of Del Mas does not teach a substantially flat image coupled to the body via at least one spring, as required by amended claim 15. Instead, Del Mas teaches attachment of a “lifelike” hand 61 on the end of a spring that is attached to the body. Because Del Mas does not teach the limitation of a substantially flat image coupled to the body, Del Mas does not anticipate claim 15, and Applicants respectfully request that the rejection of claim 15 and dependent claims 18, 19, and 56 be withdrawn.

The Examiner rejected claims 16, 17, 57, and 58 under 35 U.S.C. §103(a) as being unpatentable over Del Mas in view of Micco. However, Micco does not teach or suggest, alone or in combination with Del Mas, a substantially flat image coupled to the body via at least one spring, and thus does not rectify the deficiencies of Del Mas. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 16, 17, 57, and 58.

Applicants appreciate the Examiner’s indication that claim 22 would be allowable if rewritten in independent form to include the limitations of base claim 15.

The Examiner rejected claims 23-25 and claim 31 under 35 U.S.C. §102(e) as being anticipated by Lui (U.S. Patent No. 6,511,359). Applicants respectfully traverse the rejection. However, Applicants have amended claim 23 to recite a mounting plate including an adhesive layer thereon and a removable film layer provided over the adhesive layer. Applicant further notes that Lui does not teach the use of an adhesive layer on a mounting plate, and that this limitation was indicated by the examiner as resulting in the allowability of claims 53 and 55, once these claims were amended to be in independent form. Because Lui does not anticipate claim 23 as amended, Applicants respectfully request that the rejection of claim 23 and the recited dependent claims over Lui be withdrawn.

Applicants appreciate the Examiner's indication that claim 29 would be allowable if rewritten in independent form to include the limitations of base claim 23.

The Examiner also rejected claim 32 under 35 U.S.C. §103(a) as being unpatentable over Lui. Applicants respectfully traverse the rejection. The Examiner's argument with regard to the height of the spring being a matter of design choice is tangential to Lui's lack of a teaching or suggestion of the use of an adhesive layer with a removable film on the mounting plate. Furthermore, Lui describes a device in which the photograph is slid into a receiving compartment without being actually attached to the mounting plate, which teaches away from the use of an adhesive. Accordingly, for at least these reasons, Lui does not render obvious claim 32, and Applicants respectfully request that the rejection of claim 32 be withdrawn.

The Examiner rejected claims 40, 41, and 43 under 35 U.S.C. §102(b) as being anticipated by Del Mas. More specifically, the Examiner has asserted that the body portion (10) is a background image, and further that the background image "could be considered an advertisement" or "could be served as a reminder such as a board for a sticky note reminder." Applicants respectfully traverse the rejection. At the outset, Applicant notes that to anticipate a claim, a single source must contain all of the elements of the claim, and that missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. Accordingly, claims 41 and 43 are not anticipated by Del Mas, because Del Mas does not teach a background image that is an advertisement or a board for a sticky note reminder.

With regard to independent claim 40, Del Mas does not anticipate a wobble image that wobbles in front of a background, as claimed, for at least the reason that the body portion taught by Del Mas is not a background as defined by Applicants. As stated in MPEP 2111.01, the words of a claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. However, equating a body portion with a background is inconsistent with how a background is described by Applicant's specification. For example,

in paragraph [0066] of the specification, Applicant states that the figures illustrate “bodies or backgrounds,” (emphasis added) in effect clearly distinguishing the two. Because Applicants have clearly distinguished between body images and background images, claim 40 is not anticipated by Del Mas, in which the “background image” is a body image. Accordingly, for the reasons provided above, Applicants respectfully request that the rejection of claims 40, 41, and 43 be withdrawn.

The Examiner has also rejected claims 42 and 45 under 35 U.S.C. §102(b) as being unpatentable over Del Mas, or Del Mas in view of Micco, respectively. Applicants respectfully traverse the rejections. Furthermore, Micco does not overcome the deficiency regarding the lack of a teaching or suggestion of a background image, as claimed by Applications. Accordingly, Applicants also respectfully request the withdrawal of the rejection of claims 42 and 45.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 35502US1.

Respectfully submitted,
PEARNE & GORDON, LLP

By: 
Una L. Lauricia – Reg. No. 48,998

1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

Date: June 4, 2008